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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590 05/03/2006				
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK,, NY 10022-2585			EXAMINER FISCHETTI, JOSEPH A	
			ART UNIT 3627	PAPER NUMBER

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,686

Applicant(s)

MASUDA ET AL.

Examiner

Joseph A. Fischetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/13/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

112 Second Paragraph Rejection

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 as amended cannot be understood because in lines 8 and 9, it is stated that "the accounting quantity for each accounting method is calculated based on said plurality of accounting methods". The problem with this recitation is that it states for each accounting method all accounting methods are used to make the calculation. It appears wrong in that only the accounting method involved in the given quantity should be used to calculate that involved accounting quantity rather than using the plurality of accounting methods to make this calculation as the claim presently recites.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,7 insofar as can be understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillis in view of Ehlers et al. and Theil.

Hillis discloses a method of displaying an accounting state for a communication service by a terminal device, comprising steps of receiving a communication service (block 40 user enters number), to which a plurality of accounting methods can be applied (account method for fixed location vs. accounting method for conference call vs. accounting method for ISU to ISU, rates are variable and hence are accounting based results), from a network and providing the communication service for a subscriber; and displaying accounting quantities corresponding to each of said plurality of accounting methods in the process of utilizing the communication service (col. 6 lines 50 et seq. since the displayed rate result of an other accounting practice is shown in the process of its use without deference to any other method, the claim meets this limitation).

But, Hillis fails to disclose an accounting method of each of said plurality of accounting methods differing mutually, calculating accounting quantities during the process of utilizing the device based on the plurality of accounting methods for the communication service part which has been already received.

However, Ehlers et al. disclose displaying (col. 31 lines 28-34) during the use process a rate from one of different rates to calculate the lowest cost as between plural accounting methods, e.g., manual cost entry or manual cost entry, see also, col. 33, line 14, "if selected". It also discloses calculating each supplier's rates on an hour by hour rate see col. 33 lines 1, 2 and calculates using a selected accounting practice. But not all the results are presented only the lowest cost. But, Thiel does allow all combinations of different accounting method and carries to be displayed to the user for his/her selection col. 10 lines 39 et seq. It would be obvious to modify the device in Hillis

to include the display feature of Ehlers et al. which on-going tracks the rates of various carriers and to have each rate calculated with a different accounting method displayable to the user as taught by Theil the motivation being the ability to see bottom line pricing at the time of usage and to make a change at that point in time.

Re claim 3: the specified accounting quantity is read as the selection in Ehlers et al. between manual cost entry or manual cost entry, the motivation is again herein repeated.

Re claim 7: Hillis disclose notifying the network of pieces of information when he discloses accepting the call at col. 6, line 27, the motivation is again herein repeated.

Claims 1,2,4,5,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillis in view of Ehlers et al. and Theil as applied to claims 1,3,7 above, and further in view of Kikuchi et al.

Hillis in view of Ehlers et al. and Theil. disclose the invention substantially as claimed except they fail to disclose the specifics of claims 2,4,5,6. However, Kikuchi et al., re claim 2, disclose obtaining a piece of information on an accounting degree (see unit fee per unit time information 121) corresponding to each of said plurality of accounting methods from said network when the communication service starts being utilized; and measuring, in the process of utilizing the communication service, an quantity of an accounting element corresponding to an accounting method, (speech fee process 208) calculating and displaying said accounting quantity (display 212 displays the fee from the calculation made by timer 206). It would be obvious to modify the above combination with the features of Kikuchi et al. the motivation being the more

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efficient procurement of information costs which ultimately results in the lowest fees to be paid by the user.

RE claim 4 it is deemed a mere repetition of steps to calculate and display the fee for various other rates stored in the unit fee database and since these fees while at some point appear on the display 150, they are deemed to have been shown "together".

Re claim 5 and 6, the use of an alarm to sound when a value is exceeded is deemed to be an old and notorious expedient in the art.

FINAL ARGUMENTS

The 122 second problem presented in the last response makes it unclear to the examiner just what demarcation applicant was intending to make against the prior art. The remarks merely re-recited the limitation in question without elaboration which could have otherwise given a glimpse into the intention behind the language which the examiner could have used to better speculate what was the intent of the language.


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (703) 305-0731.


JOSEPH A. FISCHETTI
PRIMARY EXAMINER

Joseph A. Fischetti
Primary Examiner
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